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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,437	09/19/2005	Mikio Fukumura	SAEG120.002APC	7861
20995 7590 01/11/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER LEYSON, JOSEPH S	
			ART UNIT	PAPER NUMBER
			1722	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/11/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/11/2007.

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Office Action Summary	Application No. 10/518,437	Applicant(s) FUKUMURA, MIKIO	
	Examiner Joseph Leyson	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, Species A, drawn to Figs. 1 and 2 and to claims 1, 2 and 5-8, in the reply filed on October 31, 2006 is acknowledged.
2. Claims 3, 4 and 9-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention or non-elected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 31, 2006.

Specification

3. The abstract of the disclosure is objected to because it is more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Silvasy et al. (U.S. Patent 2,771,637).

Silvasy et al. (U.S. Patent 2,771,637) teach a forming die including an inlet (i.e., figs. 1-3) for inserting extrusion material from an extruder 12, 13, a hollow portion (i.e., the spreading out portion of 16) formed so as to permit the material inserted to spread in the widthwise direction (i.e., fig. 2), and a channel (i.e., the end portion of 16) for discharging the material that has passed through the hollow portion and is spread in the widthwise direction, wherein one end of the channel is narrowed by two rotatable bodies 17 to form a discharge portion, the two rotatable bodies 17 having an outer periphery substantially in the form of a true circle in cross section and being disposed in parallel with their axes extending in the widthwise direction (i.e., figs. 1-3), and the discharge portion for discharging the material being formed by a gap (i.e., fig. 3) between the rotatable bodies 17, and the two rotatable bodies 17 can rotate in the material discharging direction (i.e., see arrows in fig. 3), and a forming device 20 for forming an article discharged from the discharge portion into a predetermined shape at the downstream side of the discharge portion. As to the recitations such as "foam forming" and "for inserting a molten resin containing a foaming agent", such recitations relate to the intended use of the apparatus and do not have any patentable weight. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); see MPEP 2114.

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See MPEP 2115.

6. Claim 1 is are rejected under 35 U.S.C. 102(e) as being anticipated by Vinson (U.S. Patent 6,406,752).

Vinson (U.S. Patent 6,406,752) teaches a foam forming die 10 including an inlet (i.e., or supply port; col. 4, lines 54-62) for inserting an extrusion material, a hollow portion 20 formed so as to permit the material inserted to spread in the widthwise direction (i.e., fig. 2; col. 4, line 65, to col. 5, line 5), and a channel 30 for discharging the material that has passed through the hollow portion 20 and is spread in the widthwise direction, wherein one end of the channel 30 is narrowed by two rotatable bodies 50 (i.e., fig. 3) to form a discharge portion (i.e., col. 5, lines 52-56), the two rotatable bodies having an outer periphery substantially in the form of a true circle in cross section and being disposed in parallel with their axes extending in the widthwise direction, and the discharge portion for discharging the molten resin being formed by a gap between the rotatable bodies 50, and the two rotatable bodies can rotate in the molten resin discharging direction (i.e., col. 6, lines 4-15). As to the recitations such as "foam

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forming" and "for inserting a molten resin containing a foaming agent from an extruder", such recitations relate to the intended use of the apparatus and do not have any patentable weight. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); see MPEP 2114. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See MPEP 2115.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Silvasy et al. (U.S. Patent 2,771,637) or Vinson (U.S. Patent 6,406,752).

Silvasy et al. (U.S. Patent 2,771,637) and Vinson (U.S. Patent 6,406,752) each disclose the die substantially as claimed, as mentioned above, except for the

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dimensional requirements of instant claim 2 or for the rotation adjusting means of instant claim 6.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the die of either Silvasy et al. (U.S. Patent 2,771,637) or Vinson (U.S. Patent 6,406,752) to have the dimensional requirements of instant claim 2 because where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device, In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the rotatable bodies of either Silvasy et al. (U.S. Patent 2,771,637) or Vinson (U.S. Patent 6,406,752) with a rotating adjusting means because such means would enable adjustment depending upon processing requirements and/or because adjustability, where needed, is not a patentable advance, In re Stevens, 212 F.2d 197, 101 USPQ 284 (CCPA 1954). Note that Vinson (U.S. Patent 6,406,752) discloses that the rotation speed can be variable depending upon processing requirements (i.e., col. 64-57).

9. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Silvasy et al. (U.S. Patent 2,771,637) or Vinson (U.S. Patent 6,406,752) in view of Bardy (U.S. Patent 5,453,238).

Silvasy et al. (U.S. Patent 2,771,637) and Vinson (U.S. Patent 6,406,752) each disclose the die substantially as claimed, as mentioned above, except for the plurality of inlets of instant claim 5 or for the projections of instant claim 7.

Bardy (U.S. Patent 5,453,238) discloses a plurality of inlets for making a multilayer product (i.e., fig. 1) and a projections on a rotatable body 8 (i.e., fig. 2; col. 3, lines 35-43) to impress a profile on the product.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the die of either Silvasy et al. (U.S. Patent 2,771,637) or Vinson (U.S. Patent 6,406,752) to have a plurality of inlets because such a modification would enable the die to make multilayered products, as disclosed by Bardy (U.S. Patent 5,453,238), or to modify the rotatable bodies of Silvasy et al. (U.S. Patent 2,771,637) or Vinson (U.S. Patent 6,406,752) to have projections because such a modification would enable a profile to be impressed into the product, as disclosed by Bardy (U.S. Patent 5,453,238).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nalle, Jr. (U.S. Patent 3,394,431) and Nodono et al. (U.S. Patent 6,685,460) are cited as of interest to show the state of the art.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (571) 272-5061. The examiner can normally be reached on M-F 9AM-5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gupta Yogendra can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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